

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Alex L. Chan et al.
	:	
For	:	SHARED VIA DECOUPLING FOR AREA
	:	ARRAYS COMPONENTS
	:	
Serial No.:	:	10/761,343
	:	
Filed	:	January 22, 2004
	:	
Art Unit	:	2841
	:	
Examiner	:	Hoa Cao Nguyen
	:	
Att. Docket	:	ALC 3113
	:	
Confirmation No.	:	3273

REPLY BRIEF

Mail Stop Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed on July 10, 2008.

I. STATUS OF CLAIMS

Claims 1-6 and 9-12 are on appeal.

Claims 1-6 and 9-13 are pending.

No claims are allowed.

Claims 1-6 and 9-12 are rejected.

Claims 7 and 8 are canceled.

Claim 13 is withdrawn.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

- A. Claims 2-12 are rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite.
- B. Claims 1-4 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2003/0043560 to Clarkson et al. (hereinafter "Clarkson").
- C. Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Clarkson.

III. ARGUMENTS

The following remarks are directed to the new points of argument raised in the Examiner's Answer mailed on July 10, 2008.

On page 3, the Examiner's Answer sets forth a new rejection under 35 U.S.C. § 112, second paragraph. The Examiner alleges that "claims 9 and 10 were rejected by the same seasons [sic] as the rejected claims 7 and 8" in the Final Office Action mailed on December 4, 2007. However, this allegation does not accurately report the previous Office Action. Instead of rejecting claims 9 and 10, page 4 of the Final Office Action improperly declared that "claims 9 and 10 are also withdrawn from consideration in this Office Action."

On page 5 of the Examiner's Answer, the Examiner repeats this error, improperly declaring that "claim 9 is withdrawn from consideration" and that "claim 10 is not considered." Appellant respectfully submits that there is no authorization for withdrawal of claims in this manner. Instead, as set forth in M.P.E.P. § 2143, all claim limitations must be considered by the Examiner.

A claim limitation which is considered indefinite cannot be disregarded. In *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984), the Examiner rejected the claims on appeal on indefiniteness grounds only. The Examiner's rejection was reversed and the Board remanded the case to the examiner for consideration of pertinent prior art.

Here, although the Examiner alleges on page 5 of the Examiner's Answer that he "does not know what the actual structure the applicants try to claim" in claim 9, it is evident that claim

9 is analogous to finally rejected claim 5. Thus, Appellant submits that claim 9, if amended in the same manner as claim 5, would also be allowable.

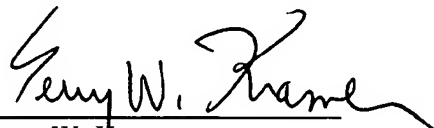
The Examiner's "withdrawal" of claim 9 is improper, as claim 9 should be indicated to be allowable if amended to overcome the rejection under 35 U.S.C. § 112, second paragraph. In the alternative, the case should be remanded to the Examiner for full review of claim 9 with respect to the prior art as Examiners are not authorized to "withdraw" claims simply because they are alleged to be indefinite. Moreover, the Examiner's Answer repeats a clearly erroneous assertion in the Examiner's Answer, applying 35 U.S.C. § 112, second paragraph, to withdraw claims from consideration instead of examining all subject matter in pending claims.

It is respectfully submitted that the remaining points of argument set forth in the Examiner's Answer are repetitive, and thus were fully addressed in Appellant's Appeal Brief. For the reasons set forth herein and in the Appeal Brief, Appellant respectfully requests that this Honorable Board reverse the rejections of the claims under 35 U.S.C. §§ 102, 103, and 112.

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Attorney's Docket No: ALC 3113

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Respectfully submitted,
KRAMER & AMADO, P.C.

A handwritten signature in cursive script, appearing to read "Terry W. Kramer", written over a horizontal line.

Terry W. Kramer
Registration No.: 41,541

Date: September 9, 2008

KRAMER & AMADO, P.C.
1725 Duke Street, Suite 240
Alexandria, VA 22314
Phone: 703-519-9801
Fax: 703-519-9802